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December 29, 2005

TO : U.S. Patent and Trademark Office

ATTN: Examiner Mark S Blouin

FAX NO.: 571-273-8300

TELEPHONE:

FROM: Stephen T. Boughner

RE: After Final Communication

YOUR REFERENCE: SS-18652-US

OUR DOCKET: 1293.1860

NO. OF PAGES (Including this Cover Sheet) 4

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RESPONSE UNDER 37 CFR 1.116
EXPEDITED PROCEDURE
EXAMINING GROUP 2653
Docket No.: 1293.1860

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re the Application of:

Un-jin CHOI

Serial No. 10/635,682

Group Art Unit: 2653

Confirmation No. 1771

Filed: August 7, 2003

Examiner: Mark S. Blouin

For: OPTICAL PICKUP UNIT FEEDING APPARATUS AND OPTICAL DISC DRIVE USING
THE SAME

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REQUEST FOR NEW OFFICE ACTION

Commissioner for Patents
PO Box 1450
Alexandria, VA 22313-1450

BOX AF

Sir:

This is in response to the Office Action mailed November 29, 2005, and having a period for response set to expire on February 29, 2006.

It is respectfully submitted that the outstanding Office Action is improper. The Office Action particularly sets forth that claims 1-6 and 9-18 are rejected under 35 USC § 102(e) as being anticipated by Yoshiyuki, JP 2002-279739.

However, the Office Action indicates that Yoshiyuki fails to disclose the claimed viscoelastic material, and then sets forth a obviousness rationale for further modifying Yoshiyuki.

It is respectfully submitted that the § 102 rejection is improper. The Office Action is unclear as to the official rejection being set forth by the Examiner.

Accordingly applicants respectfully request a new Office Action be issued with a proper rejection. If claims 1-6 and 9-18 are being rejected under 35 USC § 102, it is submitted that Yoshiyuki must disclose all the claimed features.

In addition, it is noted that the Office Action has relied upon Office Notice. Applicants further request that the new Office Action substantiate the Examiner's taking of Official Notice with evidence in the record.

While "official notice" may be relied upon, as noted in MPEP §2144.03, these

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circumstances should be rare when an application is under final rejection or action under 37 CFR §1.113. Official Notice unsupported by documentary evidence should be only be taken by the Examiner where the facts asserted to be well known, or to be common knowledge in the art are capable of instant and unquestionable demonstration as being well-known and only when such facts are of notorious character and serve only to "fill in the gaps" which might exist in the evidentiary showing made by the Examiner to support a particular ground of rejection.

Rather, the Office Action's taking of Official Notice would appear to be for more than just "filling in the gaps." The Office Action is proposing to substantially change the operation of Yoshiyuki from the preferred system set forth in Yoshiyuki.

The fact that no other reference has been found providing any link between the Examiner's proffered Official Notice and system such as that of Yoshiyuki is very substantive evidence that Applicant's claimed invention is not obvious.

Further, the applicant should be presented with the explicit basis on which the Examiner regards the matter as subject to official notice sufficient to allow the applicant a proper opportunity to challenge that assertion. Again, applicant respectfully demands a reference be produced and/or affidavit supporting the same be prepared by the Examiner.

MPEP § 2144.03 further notes that "[w]hile 'official notice' may be relied upon, these circumstances should be rare when an application is under final rejection." It is respectfully submitted that the present circumstances do not meet a level sufficient for such a taking of Official Notice in a final Office Action.

Further, applicants additionally request that the Office Action set forth the particular motivation being relied upon by the Examiner to make the proffered modification of Yoshiyuki.

Regardless of whether a feature is well known, a prima facie obviousness case requires the relied upon motivation be positively set forth and evidenced in the record. The Taking of Official Notice does not negate the need for motivation.

The Office Action's rationale, under the 35 USC § 102 rejection, for modifying Yoshiyuki, has set forth that it would have been obvious to merely exchange the claimed feature for features within Yoshiyuki. It is respectfully submitted that this is fundamentally incorrect.

To set forth a prima facie §103 rejection, there must be some evidenced reason for modifying a reference. Specifically, there must be evidence, outside of the present application, which motivates, leads, or suggests to one of ordinary skill to modify a reference. In addition, an "obvious to try" rationale for combining two references is not valid motivation under

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35 USC §103. In re Goodwin, 576 F.2d 375, 377, 198 USPQ 1, 3 (CCPA 1978); In re Antonie, 559 F.2d 618, 195 USPQ 6 (CCPA 1977); In re Tomlinson, 363 F.2d 928, 150 USPQ 623 (CCPA 1966).

Accordingly, with the issuance of the new Office Action confirming the actual rejection of claims 1-6 and 9-18, applicants further request the Examiner set forth the required evidence in the record supporting the underlying conclusion of the Examiner, as required by the MPEP.

Respectfully submitted,
STAAS & HALSEY LLP

Date:

12/29/05

By:

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